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14 DEC 2006

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In re Application of
BARCLAY *et al*
U.S. Application No.: 10/575,765
PCT No.: PCT/GB2004/003791
Int. Filing Date: 06 September 2004
Priority Date: 04 September 2003
Attorney Docket No.: 22557-3014
For: SYSTEM AND METHOD FOR
CREATING, MANAGING AND
EXECUTING A MULTI-ELEMENT
PROCESS FOR GENERATING A
COMPLEX ENTITY

**DECISION ON RENEWED
PETITION FOR REVIVAL
UNDER 37 CFR 1.137(b)**

This decision is in response to the "Response to Decision on Petition for Revival Under 37 CFR §1.137(b)" filed 18 August 2006.

BACKGROUND

On 16 May 2006, a decision dismissing applicants' petition to revive under 37 CFR 1.137(b) was mailed. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 18 August 2006, applicant filed the subject response which included a document titled "Affidavit of Duncan Hugh Barclay and Joan Weibel" ("Decl.") and a one-month extension and fee.

DISCUSSION

As previously indicated, a petition to revive an application on the grounds of unintentional delay pursuant to 37 CFR 1.137(b) must be accompanied by: (1) a proper reply; (2) the requisite petition fee; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any required terminal disclaimer. Applicants failed to satisfy the "unintentional delay" requirement in the initial petition.

In the renewed petition, applicants provided a second declaration by the co-

inventors, Duncan Hugh Barclay and Joan Weibel. Applicants claim that they are responsible in their capacity as individuals for the prosecution of the subject application, not from their positions in Proxim-IT. Decl. at ¶ 10. Applicants assert that all patent decisions are to be taken up jointly by both inventors. *Id.* at ¶ 11. In the petition, counsel emphasizes that the present application has never been assigned to Proxim-It or its Board. Counsel states that it is the “inventors themselves [who] can direct prosecution and that all decisions require the input of all the inventors.”

In this case, co-inventor Joan Weibel made a decision not to pursue the subject application without consulting Mr. Barclay. *Id.* at ¶ 14. Applicants claim that this was the result of Mr. Barclay being out of the country and the resulting communication difficulties in reaching him. *Id.* at ¶ 13. Applicants also state that “[t]he course of action was in contradiction with the unwritten understanding between Duncan Barclay and Joan Weibel but was taken . . . because Joan Weibel was unaware of any particular exploitation possibilities with respect to the PCT application. The financial implications of official and attorney’s fees on entering the national phase was also a factor in Joan Weibel’s decision.” *Id.* at ¶ 14. Counsel claims that “Ms. Weibel’s course of action was in contradiction with the verbal agreement between the inventors.”

Applicants’ argument has been carefully considered and dismissed.

David Keltie Associates (U.K. patent counsel) requested direction on the upcoming national phase deadline for PCT/GB2004/003791 of 04 March 2006. David Keltie Associates contacted Ms. Weibel on 31 January 2006 and again on 01 March 2006 requesting guidance. Ms. Weibel responded on 03 March 2006 directing David Keltie Associates to not file a national stage application. (Keltie Decl. filed 12 April 2006 at ¶ 4.)

Ms. Weibel is an **inventor** in the subject application as well as the Managing Director of Proxim-IT. As an inventor, Ms. Weibel has the right to determine whether to file or not to file an application. Regardless of any informal agreement between Ms. Weibel and Mr. Barclay, the fact remains that Ms. Weibel made a unilateral decision based upon financial considerations impacting the application and her co-inventor’s interests.

Ms. Weibel’s direction to her attorneys on 03 March 2006 was a deliberately chosen course of action on the part of the applicant not to pursue the application further. See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm’r Pat. 1989). An intentional course of action is not rendered unintentional when the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm’r Pat. 1988).

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As such, the delay in entering the national stage in the above-captioned application cannot be considered unintentional.

CONCLUSION

For the reasons discussed above, applicants' renewed petition to revive under 37 CFR 1.137(b) is hereby **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Applicants are advised to provide sufficient evidence in any renewed petition that the delay was unintentional or a Final Agency Decision will be issued.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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